



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/704,254 | 11/01/2000 | Blaine Garst | 10010.1070C | 3557 |
| 22804 | 7590 | 06/16/2005 | EXAMINER | |
| THE HECKER LAW GROUP 1925 CENTURY PARK EAST SUITE 2300 LOS ANGELES, CA 90067 | | | SHERR, CRISTINA O | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3621 | |

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--|-------------------------------------|--|
| Office Action Summary | Application No. 09/704,254 | Applicant(s) GARST ET AL. | |
| | Examiner Cristina Owen Sherr | Art Unit 3621 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 84-92 and 94-147 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 84-92 and 94-147 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to the applicant's amendment filed March 22, 2005. Claims 1-83 and 93 have been canceled. Claims 84-92 and 94-147 are pending in this case.

Response to Arguments

2. Applicant's arguments with respect to claims 84-92 and 94-147 have been considered but are moot in view of the new ground(s) of rejection.

Double Patenting

3. Claims 84-92 and 94-147 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-60 of U.S. Patent No. 6,188,995.

5. Although the conflicting claims are not identical, they are not patentably distinct from each other. Claims 1-60 of U.S. Patent No. 6,188,995 recite as follows:

1. In a computer operating environment comprising a software program and a software resource, an apparatus for limiting use of said software resource by said software program, comprising: an access authorization indicator associated with said software program, said access authorization indicator comprising one or more license terms for use of said software resource; a digital signature of said access authorization indicator; means in said software resource for reading said access authorization indicator; means in said software resource for determining whether said access authorization indicator is valid; means for allowing said software program to use said software resource only if said access authorization indicator is determined to be valid. (A substantial duplicate of claims 84-85 of the instant application.)
2. The apparatus of claim 1 wherein said access authorization indicator comprises terms of a site license. (A substantial duplicate of claim 86 of the instant application.)

3. The apparatus of claim 1 wherein said access authorization indicator is embedded in said software program. (A substantial duplicate of claim 87 of the instant application.)
4. The apparatus of claim 1 wherein said software resource comprises an API. (A substantial duplicate of claim 88 of the instant application.)
5. The apparatus of claim 1 wherein said software resource comprises a runtime library. (A substantial duplicate of claim 89 of the instant application.)
6. The apparatus of claim 1 wherein said software resource comprises dynamic link library. (A substantial duplicate of claim 90 of the instant application.)
7. The apparatus of claim 1 wherein said software resource comprises an applet. (A substantial duplicate of claim 91 of the instant application.)
8. The apparatus of claim 1 wherein said software resource comprises a byte code package. (A substantial duplicate of claim 92 of the instant application.)
9. The apparatus of claim 1 wherein said software resource comprises an OLE enabled application program. (A substantial duplicate of claim 94 of the instant application.)
10. The apparatus of claim 3 wherein said access authorization indicator is specified in a constant declaration area of said software program. (A substantial duplicate of claim 95 of the instant application.)
11. The apparatus of claim 3 wherein said access authorization indicator comprises a property of a property list of said software program. (A substantial duplicate of claim 96 of the instant application.)
12. The apparatus of claim 1 further comprising an identifier associated with said access authorization indicator and wherein said means for determining the validity of said access authorization indicator comprises means for determining whether said access authorization indicator is valid based on said identifier. (A substantial duplicate of claim 97 of the instant application.)
13. The apparatus of claim 12 further comprising means for receiving said identifier from an end user. (A substantial duplicate of claim 98 of the instant application.)
14. The apparatus of claim 13 further comprising means for storing said identifier in said software resource. (A substantial duplicate of claim 99 of the instant application.)

15. The apparatus of claim 12 wherein said identifier is embedded in said software program. (A substantial duplicate of claim 100 of the instant application.)
16. The apparatus of claim 15 wherein said identifier is specified in a constant declaration area of said software program. (A substantial duplicate of claim 101 of the instant application.)
17. The apparatus of claim 15 wherein said identifier comprises a property of a property list of said software program. (A substantial duplicate of claim 102 of the instant application.)
18. The apparatus of claim 12 wherein said means for determining whether said access authorization indicator is valid based upon said identifier comprises a means for digital signature authentication. (A substantial duplicate of claim 103 of the instant application.)
19. The apparatus of claim 1 further comprising means for determining whether said one or more license terms are met. (A substantial duplicate of claim 104 of the instant application.)
20. The apparatus of claim 12 wherein: said software program comprises said access authorization indicator and said identifier; said access authorization indicator comprises terms of a license for use of said software resource; said identifier comprises a digital signature of said access authorization indicator. (A substantial duplicate of claim 105 of the instant application.)
21. In a computer operating environment, a method for limiting use of a software resource by a software program comprising: receiving a request from a software program to use said software resource; obtaining an access authorization indicator associated with said software program, said access authorization indicator comprising one or more license terms for use of said software resource; obtaining a digital signature of said access authorization indicator; determining whether said access authorization indicator is valid; allowing said software program to use said software resource only if said access authorization indicator is determined to be valid. (A substantial duplicate of claims 106-107 of the instant application.)
22. The method of claim 21 wherein said one or more license terms comprises a site license. (A substantial duplicate of claim 108 of the instant application.)
23. The method of claim 21 wherein said access authorization indicator is embedded in said software program. (A substantial duplicate of claim 109 of the instant application.)

24. The method of claim 21 wherein said software resource comprises an API. (A substantial duplicate of claim 110 of the instant application.)
25. The method of claim 21 wherein said software resource comprises a runtime library. (A substantial duplicate of claim 111 of the instant application.)
26. The method of claim 21 wherein said software resource comprises a dynamic link library. (A substantial duplicate of claim 112 of the instant application.)
27. The method of claim 21 wherein said software resource comprises an applet. (A substantial duplicate of claim 113 of the instant application.)
28. The method of claim 21 wherein said software resource comprises a byte code package. (A substantial duplicate of claim 114 of the instant application.)
29. The method of claim 21 wherein said software resource comprises an OLE enabled application program. (A substantial duplicate of claim 115 of the instant application.)
30. The method of claim 23 wherein said access authorization indicator is specified in a constant declaration area of said software program. (A substantial duplicate of claim 116 of the instant application.)
31. The method of claim 23 wherein said access authorization indicator comprises a property of a property list area of said software program. (A substantial duplicate of claim 117 of the instant application.)
32. The method of claim 21 wherein said determining the validity of said access authorization indicator comprises determining whether said access authorization indicator is valid based on an identifier associated with said access authorization indicator. (A substantial duplicate of claim 118 of the instant application.)
33. The method of claim 32 further comprising accepting said identifier from a user. (A substantial duplicate of claim 119 of the instant application.)
34. The method of claim 33 further comprising storing said identifier in said software resource. (A substantial duplicate of claim 120 of the instant application.)
35. The method of claim 32 wherein said identifier is embedded in said software program. (A substantial duplicate of claim 121 of the instant application.)

36. The method of claim 35 wherein said identifier is specified in a constant declaration area of said software program. (A substantial duplicate of claim 122 of the instant application.)

37. The method of claim 35 wherein said identifier comprises a property of a property list area of said software program. (A substantial duplicate of claim 123 of the instant application.)

38. The method of claim 32 wherein a digital signature authentication means is used in determining whether said access authorization indicator is valid based upon said identifier. (A substantial duplicate of claim 124 of the instant application.)

39. The method of claim 21 further comprising determining whether said one or more license terms are met. (A substantial duplicate of claim 125 of the instant application.)

40. The method of claim 32 wherein: said software program comprises said access authorization indicator and said identifier; said access authorization indicator comprises terms of a license for use of said software resource; said identifier comprises a digital signature of said access authorization indicator. (A substantial duplicate of claim 126 of the instant application.)

41. A program storage device readable by a machine, tangibly embodying a program of instructions executable by the machine to perform a method for limiting use of a software resource by a software program, said method comprising: receiving a request from a software program to use said resource; obtaining an access authorization indicator associated with said software program, said access authorization indicator comprising one or more terms of a license for use of said software resource; obtaining a digital signature of said access authorization indicator; determining whether said access authorization indicator is valid; allowing said software program to use said software resource only if said access authorization indicator is determined to be valid. (A substantial duplicate of claims 127-128 of the instant application.)

42. The program storage device of claim 41 wherein said license comprises a site license. (A substantial duplicate of claim 129 of the instant application.)

43. The program storage device of claim 41 wherein said access authorization indicator is embedded in said software program. (A substantial duplicate of claim 130 of the instant application.)

44. The program storage device of claim 41 wherein said software resource comprises an API. (A substantial duplicate of claim 131 of the instant application.)
45. The program storage device of claim 41 wherein said software resource comprises a runtime library. (A substantial duplicate of claim 132 of the instant application.)
46. The program storage device of claim 41 wherein said software resource comprises a dynamic link library. (A substantial duplicate of claim 133 of the instant application.)
47. The program storage device of claim 41 wherein said software resource comprises an applet. (A substantial duplicate of claim 134 of the instant application.)
48. The program storage device of claim 41 wherein said software resource comprises a byte code package. (A substantial duplicate of claim 135 of the instant application.)
49. The program storage device of claim 41 wherein said software resource comprises an OLE enabled application program. (A substantial duplicate of claim 136 of the instant application.)
50. The method of claim 43 wherein said access authorization indicator is specified in a constant declaration area of said software program. (A substantial duplicate of claim 137 of the instant application.)
51. The program storage device of claim 43 wherein said access authorization indicator comprises a property of a property list area of said software program. (A substantial duplicate of claim 138 of the instant application.)
52. The program storage device of claim 41 wherein said determining the validity of said access authorization indicator comprises determining whether said access authorization indicator is valid based on an identifier associated with said access authorization indicator. (A substantial duplicate of claim 139 of the instant application.)
53. The program storage device of claim 52 wherein said method further comprises accepting said identifier from a user. (A substantial duplicate of claim 140 of the instant application.)
54. The program storage device of claim 53 wherein said method further comprises storing said identifier in said software resource. (A substantial duplicate of claim 141 of the instant application.)
55. The program storage device of claim 52 wherein said identifier is embedded in said software program. (A substantial duplicate of claim 142 of the instant application.)

56. The program storage device of claim 55 wherein said identifier is specified in a constant declaration area of said software program. (A substantial duplicate of claim 143 of the instant application.)

57. The program storage device of claim 55 wherein said identifier comprises a property of a property list area of said software program. (A substantial duplicate of claim 144 of the instant application.)

58. The program storage device of claim 52 wherein a digital signature authentication means is used in determining whether said access authorization indicator is valid based upon said identifier. (A substantial duplicate of claim 145 of the instant application.)

59. The program storage device of claim 41 in which said method further comprises determining whether said one or more license terms are met. (A substantial duplicate of claim 146 of the instant application.)

60. The program storage device of claim 52 wherein: said software program comprises said access authorization indicator and said identifier; said access authorization indicator comprises terms of a license for use of said software resource; said identifier comprises a digital signature of said access authorization indicator. (A substantial duplicate of claim 147 of the instant application.)

6. Claim 1 of U.S. Patent 6,188,995 differs since it further recites additional limitations that the instant application places in separate claim 85 rather than including them in claim 84.

7. Claim 21 of U.S. Patent 6,188,995 differs since it further recites additional limitations that the instant application places in separate claim 107 rather than including them in claim 106.

8. Claim 41 of U.S. Patent 6,188,995 differs since it further recites additional limitations that the instant application places in separate claim 128 rather than including them in claim 127.

9. However, it would have been obvious to a person of ordinary skill in the art to modify claims 1, 21 and 41 of U.S. Patent No. 6,188,995 by removing/regrouping the limitations directed to the search logic and search criteria resulting generally in the claims of the present application since the claims of the present application and the claim recited in U.S. Patent No. 6,188,995 actually perform a similar function. It is well settled that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karlson*, 136 USPQ 184 (CCPA 1963). Also note *Ex parte Rainu*, 168 USPQ 375 (Bd. App. 1969). Omission of a reference element whose function is not needed would be obvious to one of ordinary skill in the art.


Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cristina Owen Sherr whose telephone number is 571-272-6711. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3621

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


SALVATORE CANGIALOSI
PRIMARY EXAMINER
ART UNIT 222